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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,355	11/13/2003	An H. Lam	200314586-1	1440

22879 7590 03/17/2006

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EXAMINER

BAE, JI H

ART UNIT PAPER NUMBER

2115

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,355

Applicant(s)

LAM, AN H.

Examiner

Ji H. Bae

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-20 is/are rejected.
- 7) ☒ Claim(s) 11-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-4 recite the limitation "the computer system" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is no prior recitation of "a computer system" in the claim or its parent.

Claim 4 recites the limitation "a system ROM" in line 1. Examiner notes that "a system ROM" has been previously recited in claim 1. Applicant's language makes it unclear whether the system ROM recited in claim 4 is intended to be the same system ROM recited in claim 1, or a new system ROM.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Gentile, U.S. Patent Application Publication No. 2002/0147941 A1.

Regarding claim 1, Gentile teaches [claim 24]:

a processor adapted to read BIOS code from a system ROM [claim 24, processor];
a management controller coupled to said processor [claim 24, chipset]; and
a NIC coupled to the management controller [claim 24, communications system];
wherein the management controller selectively traps read accesses from the processor that targets the system ROM and, in response, causes the NIC to load network BIOS code from storage external to the system during system initialization [claim 24, Fig. 1, step 19].

Regarding claim 2, Gentile teaches a plurality of modes comprising a first mode in which the management controller traps read accesses and causes the network BIOS code to be loaded and a second mode in which the management controller does not trap read accesses and does not cause the network BIOS to be loaded.

Regarding claims 5 and 6, Gentile teaches anticipates the limitations recited in this claim and is rejected on similar grounds as claims 1 and 2.

Regarding claim 7, Gentile teaches that the CPU causes the entire externally stored BIOS software to be downloaded to the computer when a first access to the system ROM is trapped.

Claims 10 and 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Eda, U.S. Patent Application Publication No. 2002/0178242 A1.

Regarding claim 10, Eda teaches a network comprising:

a computer that comprises a ROM on which a local BIOS is stored and a management controller coupled to the ROM and to a NIC [Fig. 2]; and

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a network storage device that contains a network BIOS, said network storage device external to the computer and accessible to the computer's management controller via the NIC [Fig. 1, BIOS server 200];

wherein the management controller determines whether the management controller is to operate in a first mode or a second mode [paragraph 70, server is accessible] and, if the management controller is to operate in the first mode, the management controller emulates the computer's ROM and causes the network BIOS to be copied to and executed by the computer instead of the local BIOS [paragraph 72].

Regarding claim 14, Eda teaches that, if the management controller is to operate in the second mode, the management controller does not emulate the computer's ROM and the computer executes the local BIOS from the ROM and not the network BIOS [paragraph 71].

Regarding claim 15, Eda teaches a system comprising:

a processor adapted to read and execute BIOS code from a system ROM [Fig. 2, processor 101, flash ROM 102]; and

means for trapping read accesses from the processor to the system ROM and, in response, for causing BIOS code stored external to the system to be downloaded to the system for execution by the processor [paragraph 72].

Regarding claim 17, Eda teaches means for permitting BIOS code stored on the system ROM to be executed by the processor.

Regarding claim 18, Eda teaches a method comprising:

determining whether a first mode or a second mode is specified [server is accessible, paragraph 0070];

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if the first mode is specified, emulating a first storage device that contains executable software and, upon detection of an access to the first storage device, downloading software from a second storage device [paragraph 72]; and

if the second mode is specified, permitting the executable software contained in the first storage device to be executed [paragraph 71, local BIOS 111].

Allowable Subject Matter

Claim 11-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Cromer et al., U.S. Patent No. 6,718,464 B2;

Dayan et al., U.S. Patent No. 5,230,052;

Harmer, U.S. Patent No. 5,835,760;

Brannock, U.S. Patent Application Publication No. 2002/0194313 A1;

Hill et al., U.S. Patent No. 5,987,605;

Biondi, U.S. Patent No. 6,622,246 B1;

Lin, U.S. Patent No. 6,892,323 B2;

Stevens, U.S. Patent No. 6,633,976 B1;

Rothman et al., U.S. Patent Application Publication No. 2004/0123093 A1;

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Li et al., U.S. Patent Application Publication No. 2003/0236853 A1;

Klimenko, U.S. Patent No. 5,974,547;

Flaherty et al., U.S. Patent No. 5,280,627;


Burokas et al., U.S. Patent No. 6,954,852 B2;

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji H. Bae whose telephone number is 571-272-7181. The examiner can normally be reached on Monday-Friday, 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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